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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,096	04/12/2000	HANS TANDLER	GK-ZEI-3078	5855

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EXAMINER

FINEMAN, LEE A

ART UNIT PAPER NUMBER

2872

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/463,096

Applicant(s)

TANDLER ET AL.

Examiner

Lee Fineman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15 and 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. The final rejection mailed 05 June 2002 has been withdrawn. Any inconvenience to the applicant is regretted.

Drawings

2. The drawings are objected to because of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

✓ 3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

✓ 4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The drawings fail to show a second control unit. This feature must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 13-15 and 17-23 are objected to because of the following informalities:

✓ In claim 13, line 7, “additional monitoring system” is recited. It is unclear to what the monitoring system is in addition. The dependent claims inherit the deficiencies of the claim 13 from which they depend.

✓ Claim 14 recites the limitation “two lens members” in line 1, which is ambiguous. It is unclear whether these two lens members are further defining the “at least one moving lens system” or an independent feature thereto. For the purpose of examination, the examiner will consider the two lens members as part of the “at least one moving lens system.”

✓ Claim 15 recites the limitation “lens members” in line 1, which is ambiguous. It is unclear whether these lens members are further defining the “at least one moving lens system” or an independent feature thereto. For the purpose of examination, the examiner will consider the lens members as part of the “at least one moving lens system.”

✓ Claim 19 recites the limitation “lens pairs” in line 2, which is ambiguous. It is unclear whether the lens pairs are further defining the “at least one moving lens system” or an independent feature thereto. For the purpose of examination, the examiner will consider the lens pairs as part of the “at least one moving lens system.”

✓ Claim 20 recites the limitation “a plurality of moving lens members” in line 1, which is ambiguous. It is unclear whether the plurality of moving lens members is further defining the “at least one moving lens system” or an independent feature thereto. For the purpose of examination, the examiner will consider the plurality of moving lens members as part of the “at least one moving lens system.”

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Claim 21 recites the limitation "at least two lens members" in line 1, which is ambiguous.

It is unclear whether the at least two lens members are further defining the "at least one moving lens system" or an independent feature thereto. For the purpose of examination, the examiner will consider the at least two lens members as part of the "at least one moving lens system."

Claim 23 recites the limitation "control units" in line 1, which is ambiguous. It is unclear whether the control unit in claim 13 is included within these control units or whether these control units are additional. For the purpose of examination, the examiner will consider the control unit of claim 13 as one of the control units of claim 23.

Claim 22 recites the limitation "the operator" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 13-15 and 17-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to specifically identify that no additional monitoring system (claim 13, line 7) is included. The applicant is now relying on this limitation as criticalness to the

patentability. As such, the examiner contends, absent specific support in the specification, that this subject matter was not considered within the metes and bounds of the invention as originally filed. The dependent claims inherit the deficiencies of the claim 13 from which they depend.

Claim 23 recites control units. The applicant is directed to figures 2 and 3, which illustrate only one control unit (AE). As such, neither the specifications nor the drawings supports this claimed limitation.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 13-15, 17, 20-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figure 1 of the instant application which is admitted prior art (Admission) in view of Thomas, U.S. Patent No. 4,161,756.

Regarding claim 13 and 17, Admission discloses a stereomicroscope with a zoom system (fig. 1) comprising a drive motor (M) driving at least one moving lens system (L1, L2). Admission lacks the driving motors being controlled by a control unit which reads calculated pre-stored values of reference points from a mathematical controlling curve for directing the movement of the at least one moving lens system by controlling the driving motors in a corresponding manner without necessitating use of mechanical generation of the mathematical controlling curve and without an additional monitoring system. Thomas teaches a zoom system

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with linear driving motors (5,6) being controlled by a control unit (45) which reads calculated pre-stored values of reference points from a mathematical controlling curve for directing the movement of the at least one moving lens system by controlling the driving motors in a corresponding manner without necessitating use of mechanical generation of the mathematical controlling curve (column 1, lines 24-27 and column 2, lines 5-12) and without an additional monitoring system (no other monitoring systems to those disclosed are present) and further the driving motors are arranged between lens pairs (driving motor 5 and 6 are between lens pairs 1 and 18, fig. 1; Thomas). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the drive unit of Admission with the drive unit of Thomas to allow for a larger number of adjustment positions and a more accurate driving system (column 2, line 2).

Regarding claim 14 and 21, Admission in view of Thomas discloses two lens members that are controlled independently from one another (column 2, lines 55-57; Thomas).

Regarding claim 15 and 20, Admission in view of Thomas discloses lens members (L1, L2) provided as lens pairs in a Greenough type stereomicroscope or telescope type stereomicroscope (Admission, fig 1). Each lens pair is a plurality of moving lens members controlled jointly.

Regarding claim 23, Admission in view of Thomas discloses a control unit used for motorized zoom adjustment and for motorized focusing (column 2, lines 50-57; Thomas). The combination does not disclose more than one control unit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have more than one control unit, since it has been held that constructing a formerly integral structure in various elements

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involves only routine skill in the art. One would have been motivated to make the control unit separable for the purpose of separating the control of zoom adjustments and focusing adjustments. *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)

10. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admission in view of Thomas as applied to claims 13-15, 17, 20-21, and 23 above, and further in view of Official Notice.

Regarding claim 18, Admission in view of Thomas discloses the claimed invention except for the linear drives being arranged in the stereomicroscope housing. Official Notice is taken that having linear drives be arranged in a device housing is well known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the linear drives of Admission in view of Thomas be arranged in the stereomicroscope housing in order to make the overall device more compact.

Regarding claim 19, Admission in view of Thomas discloses the driving motors are arranged between lens pairs (driving motor 5 and 6 are between lens pairs 1 and 18, fig. 1; Thomas)

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Admission in view of Thomas as applied to claims 13-15, 17, 20-21, and 23 above, and further in view of Pensel et al, U.S. Patent No. 5,867,308.

Admission in view of Thomas discloses the claimed invention except for a linear magnification that is adjusted is determined and displayed to an operator during the controlling of the zoom system. Pensel et al. teaches a linear magnification that is adjusted is determined and

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displayed to an operator during the controlling of the zoom system (12, fig. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the linear magnification of Admission in view of Thomas that is adjusted be determined and displayed to an operator as Pensel et al. suggests in order to allow the operator to arrive at a desired magnification with ease.

Response to Arguments

12. Applicant's arguments filed 5 September 2002 have been fully considered but they are not persuasive.

The applicant argues that the zoom system of Thomas is not technically compatible with the language of claim 13. The examiner disagrees. Thomas teaches the following technical features as claimed: linear driving motors (5,6) being controlled by a control unit (45) which reads calculated pre-stored values of reference points from a mathematical controlling curve for directing the movement of the at least one moving lens system by controlling the driving motors in a corresponding manner without necessitating use of mechanical generation of the mathematical controlling curve (column 1, lines 24-27 and column 2, lines 5-12 where the nonlinear law of relative displacement is the mathematical controlling curve).

Further, the applicant's arguments about the combinations of Thomas and Eumura and Biber in view of Thomas and Eumura are moot in view of the new grounds of rejection.

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Conclusion

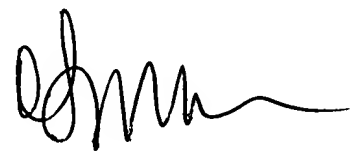
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF
September 20, 2002



Cassandra Spyrou
Supervisory Patent Examiner
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